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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/380,351 08/31/99 EDDY

E P-6374.03

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QM32/0829

EXAMINER

DEXTER, C

ART UNIT	PAPER NUMBER
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3724

DATE MAILED:

08/29/01

Please find below and/or attached an Office communication concerning this application proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/380,351

Applicant(s)
Eddy et al.

Examiner
Clark F. Dexter

Art Unit
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 11, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-33, 36-48, and 50 is/are pending in the application.
- 4a) Of the above, claim(s) 27-33, 38-47, and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 36, 37, and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Mar 5, 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

1. The amendments filed March 5, 2001 and June 11, 2001 have been entered. In view of the new amendment practice under 37 CFR 1.121 which became mandatory for all amendments on March 1, 2001, it is noted that due to the limited amount of examining time per application, if the amendment contains changes to existing language that requires a marked-up version showing those changes, the Examiner is relying upon the marked-up version(s) for examination of the application. It is applicant's responsibility to ensure that the clean version(s) is (are) the same as the marked-up version(s).

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on March 5, 2001 have been **approved**.

Claim Rejections - 35 USC § 112

3. Claims 26, 36, 37 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, line 8, “further” is vague and indefinite as to what it refers (i.e., further in view of what?), and it is suggested to simply delete it; in lines 8-9, the recitation “said pusher arm

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exerting a force on an end of said elongate metallic member” renders the claim vague and indefinite since the invention is being positively defined in terms of the work piece, and it is suggested in line 8 to insert --whereby-- after the comma “,”, and in line 9 to change “exerting” to --exerts-- or the like; in line 12, it seems that punctuation (e.g., a comma --,--) is missing after “unit”; also in line 12, “further” is vague and indefinite as to what it refers (i.e., further in view of what?), and it is suggested to simply delete it; in line 14, it seems that “wherein” should be changed to --whereby-- or the like for clarity.

In claim 37, lines 1-2, the phrase “arranged to exert a downward pressure on a part of said elongate member being cut” remains vague and indefinite as to how the roller is “arranged”, particularly since it is defined in terms of the elongate member which is not part of the claimed invention.

In claim 48, line 8, “further” is vague and indefinite as to what it refers (i.e., further in view of what?), and it is suggested to simply delete it; in lines 8-9, the recitation “said pusher arm exerting a force on an end of said elongate metallic member” renders the claim vague and indefinite since the invention is being positively defined in terms of the work piece, and it is suggested in line 8 to insert --whereby-- after the comma “,”, and in line 9 to change “exerting” to --exerts-- or the like; in line 12, it seems that punctuation (e.g., a comma --,--) is missing after “unit”; also in line 12, “further” is vague and indefinite as to what it refers (i.e., further in view of what?), and it is suggested to simply delete it; in line 14, it seems that “wherein” should be changed to --whereby-- or the like for clarity.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 26 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller, pn 4,452,118.

Muller discloses a device with every structural limitation of the claimed invention including separation unit having a cutter (e.g., 30); support means (e.g., structure upstream and downstream of the cutter); feeder means comprising a pusher arm (e.g., 58); and means to constrain lateral movement comprising at least one pair of horizontally spaced apart guide rollers (e.g., 146).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muller, pn 4,452,118.

Muller lacks the separation device comprising a roller. However, the Examiner takes Official notice that such rollers are old and well known in the art for various well known benefits including reducing vibrations of the work piece during a cutting operation. Therefore, it would have been obvious to one having ordinary skill in the art to provide rollers on one or both sides of the cutter (i.e., upstream and downstream) to gain the various known benefits including that described above.

8. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muller, pn 4,452,118.

Muller discloses a process with every active method step of the claimed invention but lacks the work piece being metallic. However, the Examiner takes Official notice that it is old and well known in the art to cut various types of elongate metallic members longitudinally. Therefore, it would have been obvious to one having ordinary skill in the art to use the cutting device of Muller to cut an elongate metallic member to longitudinally split the member into two pieces.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
August 27, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.